

REMARKS

1. In Applicant's election of species filed May 22, 2008, Applicant elected species iii consisting of claims 17-29. Further election of species was required as between "permit extension of credit" in claim 20 and "Do not permit extension of credit" in claim 29. Election also was required between "Auction server, Auction database and an account info server" of claim 23 and "Research info server" of claims 27-28. Applicants withdrew claims 27-29, leaving the elected species of claims 17-26. The examiner's further withdrawal of claims 18, 19, 21, 22, 24, 25 and 26 was made without a written rationale and is respectfully traversed.

2. Claims 17, 20 and 23 stand rejected under 35 U.S.C. § 112 on the grounds that they are drawn to a single means claim. Applicant respectfully traverses this rejection. No element of any of these claims is in means plus function format.

Applicant has not written any claims using the means plus function format. With reference to MPEP § 2181, Applicant notes that the following guidelines are given for determining whether a limitation should be construed as a "means or step plus function" limitation:

- (A) the claim limitations must use the phrase "means for" or "step for,"
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function.

None of Applicant's claims anywhere recite either the words "means for" or "step for." Therefore, Applicant believes that the claims are not properly classified as "means claims."

In In re Hyatt, the court considered the following claim language: "35. A Fourier transform processor for generating Fourier transformed incremental output signals in response to incremental input signals, said Fourier transform processor *comprising* incremental *means for* incrementally generating the Fourier transformed incremental

output signals in response to the incremental input signals.” In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (emphasis in the original). The court characterized the claim as a single means claim: “claim 35 is a single means claim. It is not disputed that it is drafted in means-plus-function format, and it is not disputable that it is drawn to a single element” id. The court’s analysis of the disputed claim was limited to whether or not the claim was a single means claim, including whether it was in means-plus-function format and whether it was drawn to a combination. While Hyatt admitted that the claim was in means-plus-function format, and Hyatt also insisted that the claim was not drawn to a combination, he still argued that the claim was not a single means claim, on the grounds that the claim recited multiple “elements” (i.e. nouns). The court found this argument unpersuasive because the nouns recited served only to describe the single means, and affirmed the rejection of the claim on the ground that it was drawn to a single means.

The court in In re Hyatt also discussed the reasoning behind the prohibition of single means claims. The court noted that a single means claim is problematic because “it covers every conceivable means for achieving the stated result, while the specification discloses at most only those means known to the inventor.” id. The court further explained this rationale, stating that the problem was one of “insufficient disclosure,” in that such a claim encompasses more subject matter than has been enabled by the disclosure. A single means claim, not being limited to any particular structure or configuration, will read on any apparatus or system that achieves the same effects, irrespective of how it achieves those effects.

Because none of the elements of the combinations claimed by Applicant are in means plus function format, none of the claims may properly be described as a single means claim. The claims at issue here are system claims limited by a recited structure and configuration. Therefore, the rejection on the grounds of being drawn to a single means is improper.

Although not entirely clear in the action, it may be that the examiner is going outside the statute and outside In re Hyatt to reject the claim for the non-statutory reason that it covers every conceivable structure for achieving the stated result. Claim 17 is directed to a computer system configured to allocate the equity shares to prospective

investors based on the clearing price. Even if the “every conceivable structure” rejection found support in the statutes, this claim does not present this situation. The claimed computer system is limited to one coupled by a communications network to a user input terminal. The configuration of the computer system is not unlimited. It must be further configured to provide information about an offering for the equity shares to at least one qualified potential purchaser and at least one non-qualified potential purchaser. Another aspect of the claim limits the computer system to one configured to accept bids only from one or more qualified potential purchasers via the communications network. To suggest that the claim covers every conceivable structure for allocating equity shares to investors ignores the complete language of the claim. The rejection under §112 should be withdrawn.

Despite the claim breadth suggested by the examiner, no prior art rejections have been identified under either §102 or §103. In the absence of such a prior art rejection, the claims should be deemed patentable in accordance with the statute.

3. All pending claims are believed to be in a form suitable for allowance. Therefore, the application is believed to be in a condition for allowance. The Applicant respectfully requests early allowance of the application. The Applicant requests that the Examiner contact the undersigned, Robert M. Asher, if it will assist further examination of this application.

4 Applicant does not believe any extension of time is required for timely consideration of this response. In the event that an extension has been overlooked, this conditional petition of extension is hereby submitted. Applicant requests that deposit account number 19-4972 be charged for any fees that may be required for the timely consideration of this application.

Date: 12/4/2008

Respectfully submitted,

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